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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,069	01/14/2000	Frederick Lo	CA990010	7857

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EXAMINER
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BROSS, EDWARD J

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 11/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/483,069

Applicant(s)

LO ET AL.

Examiner

Edward Bross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/14/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, and 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 7, and 8-11, drawn to interfacing an ERP application with a web browser using XML/HTML, classified in class 709, subclass 328.
  - II. Claims 5, 6, and 10, drawn to converting data from an ERP application into strongly typed JAVA objects using XML/HTML to define the mapping of said data to said object's attributes, classified in class 717, subclass 143.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I has utility without requiring the conversion of the ERP data as specified in invention II. The subcombination has separate utility such as displaying and manipulating ERP data in a stand-alone JAVA application. See MPEP 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Bruce Clay on September 11, 2003 a provisional election was made without traverse to prosecute the invention of I, claims 1-4, 7, and 8-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5 and 6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

#### ***Specification***

6. The use of the trademarks Java, Sun Microsystems, Java Server Pages, Visual Basic Script, Microsoft, Active Server Pages, and PeopleSoft has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 8 and 11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Beauchamp et al. (6,621,505).

9. As per claim 8, Beauchamp et al. discloses a client server ERP information handling system comprising a web browser on a client computer adapted to send requests to an ERP database and receive information from an ERP database, a web server for sending panels to and receiving requests from said browser, and a gateway object for translating between the web server and the ERP database (e.g. fig. 7).

10. As per claim 11, Beauchamp et al. discloses the limitations of claim 8 as above as well as an article of manufacture for use in a computer in accordance with the method of claim 8 (e.g. col. 30, lines 64-67).

11. Claim 7 is rejected under 35 U.S.C. 102(a) as being anticipated by the J2EE 1.2 specification and accompanying reference applications published December 17, 1999.

12. The J2EE specification discloses a method of merging Java objects (e.g. the EJB object and JSP/Servlet object, 3-4) and XML templates (e.g. XML configuration files 5-5, 5-9, 5-10, 5-14) to produce an HTML page that is displayed in a client's browser (e.g. 3-4).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 2, 3, 4, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the J2EE specification in view of Beauchamp et al.

15. As per claim 1, the J2EE specification teaches

- (a) the sending of an HTML form via a network to a browser on a client (e.g. "JSP page is returned" 3-4),
- (b) said browser issuing a request to the server optionally with data from said form (e.g. "Next, the user performs some action (perhaps posting form data)" 3-4),
- (f) merging data from a legacy source into a strongly typed Java object (e.g. legacy databases via JDBC, 2-4),
- (g) converting said object into HTML (e.g. 3-4),
- (h) sending said HTML to said browser for rendering (e.g. 3-4).

The J2EE specification does not teach

- executing ERP application requests via a network,
- (c) transferring data from said request into an ERP application,
- (d) executing said ERP application,
- (e) collecting output data from said ERP application.

Beauchamp et al. teaches

- executing ERP application requests via a network (e.g. fig. 7).
- (c) transferring data from said request into an ERP application (e.g. fig. 7).
- (d) executing said ERP application (e.g. fig. 7).
- (e) collecting output data from said ERP application (e.g. fig. 7).

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the method disclosed by the J2EE specification to implement the system described by Beauchamp as this would bring the benefit of the wealth of design and deployment tools available for applications that use the J2EE specification.

As per claim 2, the J2EE specification discloses the limitations of claim 1 as above as well as merging the data into a strongly typed Java object (e.g. 5-5). The J2EE specification does not disclose merging the data from an ERP application using an ERP Web Gateway. Beauchamp et al. discloses merging data from an ERP application using an ERP Web Gateway (Figure 7). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the method disclosed by the J2EE specification to implement the system described by Beauchamp as this would bring the benefit of the wealth of design and deployment tools available for applications that use the J2EE specification.

As per claim 3, the J2EE specification discloses the limitations of claim 1 as above as well as having the input form, data access, object definitions, and report forms stored as XML (e.g. 8-9). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the method disclosed by the J2EE specification to implement the system described by Beauchamp as this would bring the benefit of the wealth of design and deployment tools available for applications that use the J2EE specification.

As per claim 4, the J2EE specification discloses the limitations of claim 3 as above as well as using an XML file to strongly couple Java objects to the data (e.g. 5-5). The J2EE specification does not teach the use of XML to specify the presentation of the

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application data. Beauchamp et al. teaches the use of XML to specify the presentation of the application data (e.g. col. 6 lines 55-65). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the method disclosed by the J2EE specification to implement the system described by Beauchamp as this would bring the benefit of the wealth of design and deployment tools available for applications that use the J2EE specification.

As per claim 9, the J2EE specification teaches the limitations of claims 1 and 3 as above. The J2EE specification also teaches an article of manufacture for use with a computer system in accordance with the methods of claims 1 and 3 (e.g. PetStore tutorial application). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the method disclosed by the J2EE specification to implement the system described by Beauchamp as this would bring the benefit of the wealth of design and deployment tools available for applications that use the J2EE specification.

As per claim 10, the J2EE specification teaches the limitations of claim 4 as above. The J2EE specification also teaches an article of manufacture for use with a computer system in accordance with the method of claim 4. The motivation for combining these inventions is the same as given for claim 1 above (e.g. PetStore tutorial application). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the method disclosed by the J2EE specification to implement the system described by Beauchamp as this would bring the benefit of the wealth of design and deployment tools available for applications that use the J2EE specification.



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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Bross whose telephone number is 305-9705.

The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 305-8498. The fax phone numbers for the organization where this application or proceeding is assigned are 308-5355 for regular communications and 308-5355 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

EB  
October 14, 2003



JOHN FOLLANSBEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100